



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

HARTLEY *et al.*

Appl. No. 09/517,466

Filed: March 2, 2000

For: **Compositions and Methods for
Use in Recombinational Cloning
of Nucleic Acids**

Confirmation No.: 4289

Art Unit: 1655

Examiner: Johannsen, D.

Atty. Docket: 0942.4680003/RWE/BJD

RECEIVED

JUN 28 2002

Reply To Restriction Requirement and Requirement for Election of Species TECH CENTER 1600/2900

Commissioner for Patents
Washington, D.C. 20231

Sir:

In reply to the Office Action dated March 27, 2002 (Paper No. 18), requesting an election of one invention to prosecute in the above-referenced patent application, Applicants hereby provisionally elect to prosecute the invention of Group I, represented by claims 1-21, 26-34 and 36-38. As requested by the Examiner in Paper No. 18, at pages 3-5, Applicants further elect to prosecute claims drawn to nucleic acid molecules comprising *attB1* nucleotide sequences, represented by claims 1, 2, 10-21, 26-29, 32-34 and 36-38. This election is made without traverse, and without prejudice to or disclaimer of the other claims or inventions disclosed. Applicants reserve the right to pursue the remaining non-elected groups in one or more continuing applications.

In reply to the Requirement for Election of Species (*see* Paper No. 18 at pages 6-7), Applicants hereby provisionally elect to prosecute nucleic acid molecules comprising one or more transcriptional regulatory sequences, as recited in claims 10 and 11. This election is made **with** traverse. Applicants respectfully remind the Examiner that a reasonable number of species

may be claimed in different claims in a single application, provided the application includes a claim generic to all the claimed species and the claims drawn to alleged species are dependent from the generic claim(s). *See* 37 C.F.R. § 1.141(a). Moreover, when inventions are (a) species under a claimed genus and (b) related, then the question of whether or not an election of species requirement is proper must be addressed using the criteria for determining whether or not a restriction requirement is proper; if restriction is improper under the facts of the case, an election of species requirement should not be made. *See* MPEP § 806.04(b). In the present case, the claims identified by the Examiner as reciting alleged species (*viz.*, claims 10-14) are all related since they ultimately dependent from claim 1, which has been identified by the Examiner as being generic (*see* Paper No. 18 at page 6, second full paragraph). Therefore, both requirements under 37 C.F.R. § 1.141(a) are met, and it must be determined whether or not restriction would be proper in the present case to determine the propriety of the election of species requirement.

The criteria for a proper restriction are that (1) the inventions must be independent or distinct as claimed; and (2) there must be a serious burden on the Examiner if restriction is not required. MPEP § 803. Applicants respectfully assert that the individual functional or structural elements recited in claims 10-14, identified by the Examiner as independent species, are closely related in subject matter. As such, a search of one of these alleged species is likely to encompass subject matter pertinent to the patentability of all groups, particularly since the points of novelty of the individual nucleic acid molecules recited in claims 10-14 lie primarily in claim 1 from which claims 10-14 depend. Moreover, the Examiner has not satisfied the second requirement set forth in MPEP § 803, *i.e.*, the Examiner has not shown why a serious burden would be imposed on the Examiner if restriction were not required. It should be noted that the two requirements set forth in MPEP § 803 are connected with "and." Hence, satisfaction of both is

required. The Examiner has not shown by appropriate explanation any of the three reasons supporting a serious burden if restriction were not required, as set forth in MPEP § 808.02. A serious burden therefore has not been established, and "[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions." MPEP § 803. Hence, since a restriction requirement would not be proper under the facts of the present case, Applicants respectfully assert that the Election of Species requirement is improper as well under 37 C.F.R. § 1.141 and MPEP 806.04(b). Therefore, reconsideration and withdrawal of the Election of Species requirement, and consideration of all pending claims, are respectfully requested.

It is not believed that extensions of time are required, beyond those that may otherwise be provided for in accompanying documents. However, if additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor are hereby authorized to be charged to our Deposit Account No. 19-0036.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



Brian J. Del Buono
Attorney for Applicants
Registration No. 42,473

Date: June 27, 2002
1100 New York Avenue, N.W.
Suite 600
Washington, D.C. 20005-3934
(202) 371-2600